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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,513	11/13/2000	Fuyuki Inui	Q61694	4494

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EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/709,513	Applicant(s) INUI, FUYUKI	
	Examiner Mark R. Milia	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8, 14-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8, 14-18, and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/17/05 has been entered. Currently, claims 2-6, 8, 14-18, and 21 are pending.

Claim Objections

2. Claim 18 is objected to because of the following informalities: Claim 18 is dependent from claim 13, which has been cancelled. Examiner will treat claim 18 as if it was dependent from claim 14. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Applicant's amendment to claims 5 and 17 to replace the relative term "high" with "occurring more frequently than a predetermined threshold" has overcome the rejection as cited in the Final Office Action dated 6/6/05. Therefore the rejection has been withdrawn.

5. Claims 1, 5, 6, 8, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 5, 6, 8, and 14 recite the limitation "said designated content" in the last limitation. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2, 6, 8, 14, 18, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5488423 to Walkingshaw et al.

Regarding claim 2, Walkingshaw discloses a printing apparatus for printing out contents to be displayed on a monitor and carried on broadcast signals onto paper, comprising: a receiving unit for receiving the broadcast signals including contents (see Fig. 1 "100" and column 3 lines 40-52 and 59-67), a detecting unit for detecting the

contents from the broadcast signal received by said receiving unit based on an order of priority which a user sets (see column 3 line 59-column 4 line 3, column 4 lines 16-32, and column 4 line 56-column 5 line 16, reference shows that a user selects product categories related to the type of coupons a user wishes to receive, thus a priority of categories is set by the user), and a selector for selecting printing contents from the received contents according to the order of priority and allows said printing contents to be printed, further comprising a print judging unit for instructing said printing unit to print said designated contents when a print designation code for designating the category of pre-stored designated contents coincides with a category code for specifying the category of said designated contents carried on the broadcast signals (see column 3 line 59-column 4 line 3 and column 4 line 56-column 5 line 16).

Regarding claim 6, Walkingshaw discloses a printing apparatus for printing out contents to be displayed on a monitor and carried on broadcast signals onto paper, comprising: a receiving unit for receiving the broadcast signals including contents (see Fig. 1 "100" and column 3 lines 40-52 and 59-67), a detecting unit for detecting the contents from the broadcast signal received by said receiving unit based on an order of priority which a user sets (see column 3 line 59-column 4 line 3, column 4 lines 16-32, and column 4 line 56-column 5 line 16, reference shows that a user selects product categories related to the type of coupons a user wishes to receive, thus a priority of categories is set by the user), and a selector for selecting printing contents from the received contents according to the order of priority and allows said printing contents to be printed, wherein the printing apparatus prints out said designated contents and

information relating to said designated contents, onto the paper (see column 3 line 59-column 4 line 3, column 4 line 56-column 5 line 16, and column 5 lines 28-45).

Regarding claim 8, Walkingshaw discloses a printing apparatus for printing out contents to be displayed on a monitor and carried on broadcast signals onto paper, comprising: a receiving unit for receiving the broadcast signals including contents (see Fig. 1 "100" and column 3 lines 40-52 and 59-67), a detecting unit for detecting the contents from the broadcast signal received by said receiving unit based on an order of priority which a user sets (see column 3 line 59-column 4 line 3, column 4 lines 16-32, and column 4 line 56-column 5 line 16, reference shows that a user selects product categories related to the type of coupons a user wishes to receive, thus a priority of categories is set by the user), and a selector for selecting printing contents from the received contents according to the order of priority and allows said printing contents to be printed, further comprising a control unit for combining information showing the contents of said designated contents in said designated contents wherein said printing unit prints out an image, which is combined by said control unit with information showing the contents of said designated contents (see column 3 line 59-column 4 line 3, column 4 line 56-column 5 line 16, and column 5 lines 28-45).

Regarding claim 14, Walkingshaw discloses a method printing out designated contents carried on broadcast signals onto paper, comprising: detecting a signal designating for printing said designated contents, said signal being carried on the broadcast signals (see column 3 lines 40-52 and column 3 line 59-column 4 line 3), and if said signal is detected at said detecting, a printing apparatus prints said designated

contents onto paper according to a user set priority, further comprising print judging for instructing said printing to print said designated contents when a category code for specifying the category of said designated contents, carried on the broadcast signals, coincides with a print designation code designated previously (see column 3 line 59-column 4 line 3 and column 4 line 56-column 5 line 16).

Regarding claim 21, Walkingshaw discloses a printing apparatus for printing out contents to be displayed on a monitor and carried on broadcast signals onto paper, comprising: a receiving unit for receiving the broadcast signals including contents (see Fig. 1 "100" and column 3 lines 40-52 and 59-67), a detecting unit for detecting the contents from the broadcast signal received by said receiving unit based on an order of priority which a user sets (see column 3 line 59-column 4 line 3, column 4 lines 16-32, and column 4 line 56-column 5 line 16, reference shows that a user selects product categories related to the type of coupons a user wishes to receive, thus a priority of categories is set by the user), and a selector for selecting printing contents from the received contents according to the order of priority and allows said printing contents to be printed, wherein said contents are categorized into a plurality of kinds of character or image information to be displayed on the monitor (see column 3 line 59-column 4 line 3, column 4 line 56-column 5 line 16, and column 5 lines 28-45, reference states that the coupons to be printed can contain text or images and that the information representing the coupon data is embedded in the broadcast signal that is displayed on the television).

Regarding claim 18, Walkingshaw discloses the system discussed in claim 14, and further discloses wherein said printing prints said designated contents and information relating to said designated contents (see column 5 lines 27-45).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walkingshaw as applied to claims 2 and 14 above, and further in view of U.S. Patent No. 5940582 to Akabori et al.

Walkingshaw discloses said print judging unit stores therein a plurality of said print designation codes (see column 3 line 59-column 4 line 3, column 4 lines 15-32, and column 4 line 57-column 5 line 16).

Walkingshaw does not disclose expressly a quantity detecting unit for detecting the quantity of the paper set in the printing apparatus, which are respectively listed in order of priority, and instructs said the priority when the quantity of the paper becomes adequate.

Akabori discloses a quantity detecting unit for detecting the quantity of the paper set in the printing apparatus, and wherein said print judging unit stores therein a plurality

of said print designation codes, which are respectively listed in order of priority, and instructs said the priority when the quantity of the paper becomes adequate (see column 2 lines 36-50 and 61-67, column 3 lines 1-47, column 8 lines 45-67, column 9 and column 11 lines 18-33).

Walkingshaw & Akabori are combinable because they are from printing on the basis of desire and priority.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the detection of paper quantity as described by Akabori with the system of Walkingshaw.

The suggestion/motivation for doing so would have been to increase productivity and decrease idle time by providing printed data to a user only when parameters set by the user coincide with a particular broadcast signal and an adequate amount of paper is present to execute the print job.

Therefore, it would have been obvious to combine Akabori with Walkingshaw to obtain the invention as specified in claims 3 and 15.

10. Claims 4 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Walkingshaw as applied to claims 2 and 14 above, and further in view of U.S. Patent No. 6747753 to Yamamoto.

Walkingshaw discloses a storage unit for storing the data of said designated contents (see column 3 line 59-column 4 line 3, column 4 lines 15-32, and column 4 line 57-column 5 line 16).

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Walkingshaw does not disclose expressly a quantity detecting unit for detecting the quantity of the paper said printing apparatus and wherein said print judging unit stores the data of said designated contents in said storage unit when the paper becomes unavailable.

Yamamoto discloses a quantity detecting unit for detecting the quantity of the paper said printing apparatus (see column 10 lines 62-65) and a storage unit for storing the data of said designated contents, wherein said print judging unit stores the data of said designated contents in said storage unit when the paper becomes unavailable (see column 11 lines 1-14).

Walkingshaw & Yamamoto are combinable because they are from the same problem solving area, printing documents when certain conditions are met.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the storage of data until paper becomes available as described by Yamamoto with the system of Walkingshaw.

The suggestion/motivation for doing so would have been to allow data to be received even if the printer has run out of paper therefore a user does not have to worry about losing any information.

Therefore, it would have been obvious to combine Yamamoto with Walkingshaw to obtain the invention as specified in claims 4 and 16.

Allowable Subject Matter

11. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The examiner believes that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to combine printing contents of information associated with a category code when the category code occurs more frequently than a predetermined threshold with the other limitations that appear in the current amendment to claim 5.

12. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The examiner believes claim 17 is allowable for the same reasons as set forth in the discussion of claim 5 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
Art Unit 2622

MRM



Mark R. Milia
Examiner
Art Unit 2622